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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Paul Hayward Kelly, et al.

Serial No.

10/678,190

Filed

October 6, 2003

For

PRODUCT SUPPORT AND DISPENSING SYSTEM

FOR A VENDING MACHINE

Group No.

3653

Examiner

Michael E. Butler

Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

Sir:

PETITION PURSUANT TO 37 C.F.R. § 1.144

The above-identified application was filed with 21 total claims, of which Claims 1-16 are product claims and Claims 17-21 are method claims. Sub-combination Claims 2-9 are directed to particulars of a bail cap attached to an oscillator to selectively support product containers in a stack area of a vending machine. Sub-combination Claims 10-16 are directed to the particulars of the oscillator pivotally mounted at a lower portion of one of the vending machine stack areas. Independent Claim 1 is a combination claim including all the particulars of independent sub-combination Claims 2 and 10.

In an Office Action dated July 5, 2006, the Office set forth a three-way restriction requirement for the application. More specifically, the Office held that distinct inventions are covered by Claims 1-9, drawn to a vending machine with an adjustable bail cap, Claims 10-16

drawn to a vending machine with plural staging zones and a discharge area configured to gate

variable sized products, and Claims 17-21 drawn to a method for adjusting a vending machine

stack blocking outlet size.

Following a response traversing the restriction requirement between Claims 1-16, mainly

arguing that combination Claim 1 links the independent subcombination Claims 2 and 10 such

that restriction is improper, the Office issued a second restriction requirement in an Office

Action dated October 20, 2006. This new restriction requirement now presents a four-way

restriction in the application. More specifically, the Office now holds that distinct inventions are

covered by combination Claim 1, sub-combination Claims 2-9, sub-combination Claims 10-16,

and method Claims 17-21 respectively. In other words, the Office now considers that four

separate inventions have been set forth for this application which require four separate

applications.

The Applicant respectfully submits that the October 20, 2006 Office Action does not set

forth a proper restriction requirement between Claims 1, 2-9 and 10-16. Accordingly, the

Applicant respectfully requests the withdrawal of the restriction requirement.

In particular, it should be noted that Claim 1 requires each and every limitation of Claims

2 and 10 verbatim. If either of Claims 2 and 10 are allowable, Claim 1 would clearly be

allowable. Therefore, there is no additional burden on the Office to consider Claim 1 when

considering either Claims 2 or 10. In addition, in connection with examining Claim 1, the Office

inherently searches and examines the subject matter of each of Claims 2 and 10. It is for this

reason that the Office has set up this specific combination/sub-combination restriction practice.

However, if the Office eventually determines that one of the sub-combination claims is

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allowable, the Office can then appropriately restrict out the other sub-combination. Of course, the combination claim would be combined with the allowable subcombination claim.

In addition to the above, the Office continues to improperly rely upon MPEP §806.05(d) in justifying the restriction requirement. This section clearly specifies that restriction is only proper when two or more <u>claimed</u> sub-combinations (which are only <u>disclosed</u> as usable together in a single combination) do not overlap in scope and can be shown to be separately usable.

Initially, it should be noted that the application contains two <u>claimed</u> sub-combinations, <u>claimed</u> as usable together. Therefore, the combination is claimed and not simply disclosed in the specification and thus MPEP §806.05(d) does not apply. However, even if, arguendo, MPEP §806.05(d) did apply, the Office has still failed to set forth a proper restriction. MPEP §806.05(d) states that restriction is proper <u>only</u> if the subject matter of the claimed sub-combinations does not overlap. In the present case, each of Claims 1-16 is directed to a vending machine. Sub-combination Claims 2-9 and 10-16 require several structural limitations in common (e.g., a cabinet frame, a plurality of column walls that define stack areas and a door) all of which define, at least in part, a vending machine. Note that all of these limitations are also present in Claim 1.

Thus, the Applicant respectfully submits that the sub-combination claims clearly overlap in scope and the combination is not simply disclosed in the specification but recited in Claim 1 such that restriction under MPEP §806.05(d) is improper. It is also interesting to note that the restriction requirement presented between the combination and sub-combination claims was not made utilizing the form paragraph for combination/sub-combination restrictions outlined in §806.05(d). This form paragraph specifically recites the criteria for distinctiveness and, as set

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forth above, specifically requires that the sub-combination claims to not overlap in scope and not

be obvious variants.

The Office also identifies Claim 17 as being a sub-combination claim disclosed as usable

together in a single combination. This is not the case. Claim 17 is directed to a method of

adjusting a product dispensing system for a vending machine. Accordingly, the Applicant

respectfully submits that the Office has not set forth a proper restriction requirement to Group

IV, method Claims 17-21.

Based on the above, the Applicant respectfully submits that the Office has not shown the

two-way distinctiveness required to properly restrict combination/sub-combination claims as

required by the MPEP. Thus, it is respectfully submitted that the Office Action does not set forth

a proper restriction between Claims 1, 2-9, 10-16 and 17-21. Instead, it is submitted that these

restrictions have been improperly made.

The Applicant therefore respectfully requests favorable reconsideration and the

withdrawal of the restriction requirement.

Respectfully submitted,

MUNCK BUTRUS P.C.

Date: 6-6-2007

Registration No. 39,409

P.O. Drawer 800889

Dallas, Texas 75380

(972) 628-3600 (main number)

(972) 628-3616 (fax)

E-mail: dvenglarik@munckbutrus.com

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